

## REMARKS

Reconsideration of the subject application is respectfully requested in light of the comments which follow. Claims 1-3, 5, 7-20 and 25-40 are pending.

### Restriction Requirement

On page 2 of the official Action, the Examiner alleges that claims 1, 2, 3, 5, 7 - 20, and 26 are withdrawn as being directed to nonelected subject matter. The Examiner refers to the requirement of July 20, 2004. Applicant traverses the Examiner's withdrawal of elected subject matter.

In the requirement of July 20, 2004, the Examiner alleged that the claims were directed to two different species. One species was alleged to be defined by Figures 5a and 5b, which allegedly illustrated two "similar" floorboards. The second species was alleged to be defined by Figures 5c and 5d, which allegedly illustrated "mirror imaged" floorboards. In response to that requirement, Applicant elected the species of Figures 5a and 5b, although Applicant indicated that the requirement was not understood. Thus, to the extent an election was made, the Applicant elected "similar" over "mirror imaged" floorboards.

The Examiner now attempts to redefine the requirement as being a requirement between a first species in which a locking edge locks only in the horizontal direction and a second species which locks in both the horizontal and vertical direction. Applicant submits that the Examiner has never imposed a restriction between a first species in which a locking edge locks only in the horizontal direction and a second species which locks in both the horizontal and vertical direction. And, Applicant has never made an election choosing one over the other.

The Examiner alleges that claims 27 - 32 and 36 - 40 are drawn to the elected subject matter. However, that conclusion adds even more confusion to the issue since those claims are all directed to the "mirror imaged" species that Applicant did not elect. Applicant apologizes that claims 27 - 32 and 36 - 40 were submitted after the election of species was made. However, since the Applicant has now received an examination on both species, i.e., the "similar" floorboards and the "mirror imaged" floorboards, there is no harm in continuing forth with the examination of both species.

Accordingly, Applicant submits that, to the extent that an election has been made, claims 1-3, 5, 7-20 and 25, 26, and 33 - 35 have been elected, not claims 25 and 27 - 40. However, since the Applicant has now received an examination on both species, i.e., the "similar" floorboards and the "mirror imaged" floorboards, there is no harm in continuing forth with the examination of both species.

Claims 1 - 3, 5, 7 - 20 and 26

Claims 1 - 3, 5, 7 - 20 and 26 were previously amended to recite additional features concerning the short edge connectors. Detailed arguments were presented in the response filed on December 21, 2008 that explained why such claims are patentable over the applied prior art. Those remarks are incorporated herein by reference. In view of the fact that those claims were elected, as explained in the preceding section, the Examiner must examine the claims, as amended. Applicant again submits that the claims are patentable over the applied art for the reasons previously submitted.

Claims 25 and 27 - 40

Claims 25 and 27 - 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Martensson* (U.S. Patent No. 6,763,643) in view of *Nelson* (U.S. Patent No. 2,497,837). This rejection is respectfully traversed.

The rejections made by the Examiner are the same as those made in the Official Action dated July 21, 2008. Instead of repeating the remarks made in response to the prior rejection, Applicant refers the Examiner to the remarks submitted on December 21, 2008, and incorporates them into this response.

Applicant will however address the "Response to Arguments" section of the latest Office Action, since that is the only new analysis rendered by the Examiner.

Nelson does not teach the claimed dimensions

This argument does not apply to claims 25 and 27 since those claims do not include dimensions.

With regard to the claims that include dimensions, Applicant submits that the Examiner has literally repeated the same comments made in the rejection. In other words, the Examiner has **not** responded to Applicant's prior remarks concerning dimensions. A summary of such unanswered remarks includes:

1. The passage in Nelson relied upon to teach the length of the board actually is referring to the width of the board. It does not refer to the length of the board (length of the opposing long edges).
2. *Nelson's* comment that the board has a length "**greatly** exceeding" its width actually teaches away from providing a floorboard having a **shorter** than standard

length, as provided in Claim 1. Such comment implies that longer is better than shorter.

3. The figures of *Nelson* contradict the Examiner's conclusion. The figures of *Nelson* illustrate floor gratings having a length that is ***considerably*** more than two or three times the width of the gratings.

None of those comments, previously made by the Applicant, have been addressed by the Examiner. The Examiner is referred to § 707.07(f), which ***requires*** the Examiner to answer all traversed material.

Martensson does not teach the lateral displacement

The Examiner casually refers to "laterally sliding panels along joining a mirrored connector 10". However, it is not clear how such comment refers to the language in the claims, such as "laterally displacing both the new and the second floorboard parallel with respect to the long side of the first floorboard, *the lateral displacement being longer than the length of the floorboards*".

In the "Response to Arguments" section of the latest Office Action, the Examiner has merely stated that "simply moving boards in parallel is not novel and is commonly used where a horizontal connection is possible". The Examiner does not cite any prior art to support this position. More importantly, even the Examiner's position does not address the entire relevant portion of the claim. Note the following language from claim 25: "the lateral displacement being longer than the length of the floorboards".

In accordance with § 2144.03, to the extent that the Examiner applies his prior theory to this portion of claim 25, the Examiner is requested to provide some support for the position.

Martensson does not teach the claimed sequence

Claim 25 recites, among other things, locking a new floorboard in the second row to a short side of the second floorboard in the second row, laterally displacing both the new and the second floorboard parallel with respect to the long side of the first floorboard, and angling down the second and the new floorboard after lateral displacement.

The Examiner has not addressed this specific sequence. The Examiner appears to be making a "the prior art is capable of practicing the claimed method" argument. However, this approach is improper in a method claim. See the explanation in the following section. A method claim is obvious only if each and every method step, as set forth in the claim, is taught or suggested in the prior art. However, the Examiner has not explained where the method steps are taught in the prior art.

Other Arguments Not Adequately Addressed by the Examiner

The following arguments have not been adequately addressed by the Examiner and are repeated herein.

1. "Capable of"

The Official Action appears to take the position that the floor of *Martensson* is "capable of" being made by the claimed method. By asserting that the floor in *Martensson* need only be "capable of" being made by the claimed method steps, the Official Action appears to treat the method steps merely as functional limitations in an article claim. This approach is improper in a method claim. A claim is obvious only if each and every element as set forth in the claim is found or suggested by the prior art. *Martensson* only briefly mentions any steps to follow for making the floor, noting that the joining profile 10 has lips 4 that engage in grooves 11 of the floorboards (column 7, lines 13-15), and that some portions may be "snap joinable" (column 9, line 4). There is no discussion in *Martensson* of the method steps recited in Claim 25, specifically, the locking of the second floorboard and new floorboard together at a short side, laterally displacing both boards parallel with respect to a long side of a the first floorboard, and angling the second and new floorboards down after the lateral displacement, nor are these steps inherent in *Martensson's* disclosure.

## 2. "Mirror Images are not the Same as Mirror Inverted Boards"

Claim 27 pertains to a method of installing a flooring comprising first and second types of rectangular floorboards having integrated connectors. The first and second types of floorboards are mirror-***inverted*** with regard to connectors. In the *Response to Arguments* section, the Examiner states that *Martensson* discloses "mirror images". However, mirror images are not the same as mirror inverted boards.

*Martensson* discloses a floor made from a number of **identical** floorboards 1 (see Figure 6) that are joined by separate joining profiles 10. Each floorboard 1 has identical connecting elements, shown partly as a groove 4 along four sides of the bottom of a floorboard (Figure 1) and as separate joining profiles 10. Thus, *Martensson* does not disclose a method of installing a floor using first and second types of floorboards.

Additionally, *Martensson's* floorboards are not mirror-inverted with regard to the connectors. As shown in Figures 1 and 6 of *Martensson*, the floorboards and connectors are **identical**. For the floor to be properly assembled, the joint profile 10 must be located on the same edge of all of the floorboards, when the joint profile is integrated with a single floorboard. This is further shown in Figures 6 and 8 where both long sides of each floorboard 1 has the same connector 4 and connection arrangement with joining profile 10. Similarly, each floorboard has identically arranged elements 21 and 22 along the edges of each respective floorboard. *Nelson* does not cure these deficiencies.

The Official Action makes reference to a "mirrored connector 10", however, it is not addressed how this equates to a first and second type of floorboards being mirror-inverted relative to each other with regard to the connector. This reference only addresses the connector itself, whereas the claim recites the first and second type of floorboards are mirror-inverted. Because neither *Martensson* nor *Nelson* disclose a method of installing a floor comprising first and second types of floorboards connectors arranged in a mirror-inverted manner relative to each other, withdrawal of this rejection is respectfully requested.

### 3. "Cut to Fit Argument"

The Official Action again rationalizes combining the teachings of *Nelson* with *Martensson*, "in order to fit [the board] into particular areas where available space is an important consideration". To sustain a rejection on obviousness, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. v. Teleflex Inc.* The reasoning provided in the Official Action does not meet this standard.

In the industry, whole floorboards are typically cut down to size by the installer to fit in areas where the whole board would not fit, for example, near a wall surface. This is a result of the floor area not being of a dimension that is an exact multiple of the dimension of the floorboard. This conventional process is explained in U.S. Patent No. 6,863,768 to *Haffner et al* at Column 12, lines 58-64.

*Even if a floorboard is made of smaller dimensions, some degree of cutting will likely still be necessary to ensure a proper fit and complete coverage of floor area, unless the floor area is of certain dimensions that are exact multiples of the dimensions of the floorboards. Thus, in order to fit floorboards in areas where available space is a consideration, floorboards are traditionally cut to size. Smaller floorboards would need the same treatment where they are not dimensioned to be exact multiples of the floor area. Accordingly, one of ordinary skill in the art would not manufacture a new type of smaller floorboard, but rather cut existing standard floorboards to fit in an area where available space is a consideration. Thus, the known teachings in the industry are contrary to the Examiner's asserted reasoning for combining the references.*



4. "Invention Results Are NOT Predictable"

Applicant also submits that the claimed dimensions of the floorboard offer an unexpected result that would not have been predictable to a person of ordinary skill in the art. Even if the *Nelson* patent taught the claimed dimensions, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. MPEP 2143.01, Part III.

As evidenced by declarations previously made of record in this application, the claimed floorboards provide numerous advantages that were neither expected nor predictable. The declaration by Mr. Gerhard Schultze confirms that floorboards of the claimed dimensions were not previously used in the industry because of the perception that they would lead to higher production costs and material waste. In addition, smaller floorboards were perceived to take more time to install. In Mr. Svante Bernow's declaration it is demonstrated the claimed smaller floorboards can actually be installed in a shorter amount of time than the larger, standard size floorboards. As discussed in the instant specification beginning at line 21 of page 10, the smaller size lends to easier handling of the floorboards, reduced frictional surfaces along the sides of the joint portions, greater flexibility in the boards during installation which permits a lower force to be applied when connecting the boards. As supported by the above the declarations, these results were neither expected nor predicted, as the industry favored the larger floorboards.

The Official Action indicates that Claim 29 is rejected for the same as reasons as presented in the rejection of Claim 1, and further notes that the floorboards of *Martensson* are capable of being joined in manner set forth in the claim. However,

the Official Action does not address the feature of the claim that the floor includes first and second types of floorboards, and the first type is mirror-inverted relative to the second type with regard to the connectors. As noted above, *Martensson* discloses only a single type of floorboard to be used in the assembly of a floor and does not show the mirror-inverted configuration as claimed.

5. "Rejections Are Unclear"

Similarly, the rejections of claims 25, 27, and 32 are still unclear, where an obviousness rejection is presented under §103, but the rejection is based on elements not recited in the claim. Applicant respectfully requests the Examiner to clarify the record.

The rejection refers to *Martensson* as disclosing various elements of a floorboard, then relies on *Nelson* for a teaching of specific dimensions of the floorboard. However, claims 25, 27, and 32 do not recite specific dimensions of the floorboard.

Additionally, features recited in claim 32 are not addressed in this rejection. Specifically, claim 32 recites, *inter alia*, a flooring system comprising first, second, third, and fourth types of floorboards, where the long edges of the floor boards have a length that is an even multiple of the length of the short edges, a multiple of the first and second types of floorboards is smaller than a multiple of the third and fourth types of floorboards, and the first and third types of floorboards, as compared with the second and fourth types of floorboards, respectively, are mirror-inverted with regard to the connectors. Claim 32 continues to recite that all of the first, second,

third and fourth types of floorboards are joinable with each other long side against short side, short side against short side and long side against long side.

*Martensson* does not disclose any of the above features. As noted above, all of the floorboards in *Martensson* are identical, and of uniform length (Figure 6). Thus, only one type of floorboard is disclosed. The Official Action refers to the floorboards being capable of connecting in a horizontal and vertical direction with "mirror board edge image (fig 2c)". It is not clear if this sentence is intended to identify the "mirror-inverted" relationship presented in the claim. As discussed above, the claimed mirror-inverted arrangement is not shown by *Martensson* either.

Lastly, *Martensson* shows only long side against long side connections and short side against short side connections, but does not show, discuss, or even consider a short side against long side connection. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 2, 3, 5, 7, 9-14, 16-19, 28, 30, 31, 33-40 ultimately depend from one of the independent Claims 1, 15, 25, 27, 29 or 32, which are allowable as discussed above. For at least this reason, these claims are also allowable.


Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: July 13, 2009

By:   
William C. Rowland  
Registration No. 30888

P.O. Box 1404  
Alexandria, VA 22313-1404  
703 836 6620